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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/937,016  | 09/20/2001  | Alain Gantier        | P21432              | 3081             |
| 7055  | 7590        | 07/19/2005           | EXAMINER            |                  |
| GREENBLUM & BERNSTEIN, P.L.C.<br>1950 ROLAND CLARKE PLACE<br>RESTON, VA 20191 |             |                      | MOHANDESI, JILA M   |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3728                |                  |

DATE MAILED: 07/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 09/937,016             | GANTIER, ALAIN      |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | Jila M. Mohandes       | 3728                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 14-44 and 46-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 14-23,25-44 and 46-61 is/are rejected.
- 7) Claim(s) 24 is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. ____ .   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: ____ .                                   |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 12, 2004 has been entered.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. It is noted that the term "snowboard boot" in the preamble has been accorded no weight in the examination in keeping with the courts instructions in *Kropa v. Robie*, 187 F.2d 533, 88 USPQ 478.

4. Claims 29, 32-34, 42 and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by Phillips et al. (3,783,534). Phillips '534 discloses an assembly comprising: a shoe and a device (protective cover (30) with solid, rigid strip 40) for flexural stiffening of the shoe; said shoe comprising: an upper including a flexion fold zone, a tibial support zone having an upper front surface, a flexible front end zone; and a sole; said device including a rigid cover covering said upper front surface of said shoe

and extending from said flexion fold zone of said shoe to said front end zone of said shoe; said cover being fixed to the shoe in the front end zone area; said cover being fixed to the upper of the shoe at said flexion fold zone and/or to said tibial support zone; said cover being more rigid than said upper front surface and said flexion fold zone of the shoe, since the cover is more rigid than the upper front surface (specially when made of metal), it will inherently interfere with the free flexing of the shoe to some extent.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. It is noted that the term "snowboard boot" in the preamble has been accorded no weight in the examination in keeping with the courts instructions in *Kropa v. Robie*, 187 F.2d 533, 88 USPQ 478.

7. Claims 14-23, 25-28, 30-31, 35-41, 43-44, 46-52 and 54-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips et al. (3,783,534) in view of Ellis et al. (3,206,874). Phillips '534 discloses an assembly comprising: a shoe and a device (protective cover (30) with solid, rigid strip 40) for flexural stiffening of the shoe; said shoe comprising: an upper including a flexion fold zone, a tibial support zone having an upper front surface, a flexible front end zone; and a sole; said device including a rigid cover covering said upper front surface of said shoe and extending from said flexion fold

zone of said shoe to said front end zone of said shoe; said cover being fixed to the shoe in the front end zone area; said cover being fixed to the upper of the shoe at said flexion fold zone and/or to said tibial support zone; said cover being more rigid than said upper front surface and said flexion fold zone of the shoe, since the cover is more rigid than the upper front surface (specially when made of metal), it will inherently interfere with the free flexing of the shoe to some extent. Phillips does not disclose the cover being fixed to the sole and extending to the metatarsophalangeal articulation zone. Ellise '874 discloses a cover for a shoe which is fixed to the sole beneath said front end zone of said upper by means of a journal connection and insert and which extends to the front of the toe to provide more protection in the toe area. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to fix the cover of Phillips '534 to the sole by a journal/insert connection and extend it to the front of the shoe as taught by Ellis '874 to provide more protection in the front of the shoe.

With respect to claims 16, 17, 20-22, 37, 38, 46 and 47, note the journal connection/insert (hinge 40 and plate 38) in Figures 1 and 2 embodiments of Ellis '874.

With respect to claim 23, the insert (40 & 38) is on opposite sides of said sole.

With regard to claims 26, 32 and the immobilizing means, note the strap (36) in Figure 1 embodiment of Phillips '534.

With respect to claims 27, 43 and 48 Ellis '874 discloses that the cover can be made of different materials, which inherently will have different rigidity. (see column 3, lines 2-6). Therefor, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a plurality of covers made from different

materials having varying rigidities, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

With respect to 50, 51, 52, 55, 57 and 61, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the cover of Phillips '534 as a single piece as taught by Ellis '874, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stone works*, 150 U.S. 164 (1893).

***Allowable Subject Matter***

8. Claim 24 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

9. Applicant's arguments with respect to claims 14-44 and 46-61 have been considered but are moot in view of the new ground(s) of rejection.

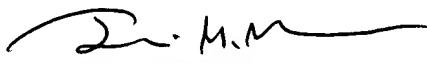
***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shown are shoe and devices analogous to applicant's instant invention.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M. Mohandes who whose telephone number is (571) 272-4558. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JILA M. MOHANDESI  
PRIMARY EXAMINER  
Jila M Mohandes  
Primary Examiner  
Art Unit 3728

JMM  
July 15, 2005